In response to the Office Action mailed on November 16, 2007, the Applicants respectfully request reconsideration in view of the following remarks. In the present application, claim 1 has been amended. Support for the amendments can be found in the specification at least on page 5, lines 14-24. No new matter has been added.

Claims 1, 2, 4-10, 12-22, 24-27, and 29-36 are pending in the application. In the Office Action claims 1, 2, 4-10, 12-22, 24-27, and 29-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Middeke et al. (U.S. Patent No. 6,445,907, hereinafter "Middeke") in view of Herrbach et al. (U.S. Patent No. 6,269,150, hereinafter "Herrbach").

Claim Rejections - 35 U.S.C. §103(a)

Claims 1, 2, 4-10, 12-22, 24-27, and 29-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Middeke in view of Herrbach. The rejection of these claims is respectfully traversed.

Claim 1, as amended, specifies a method for analyzing the operation of a media delivery device. The method includes determining whether a network connection is functional; determining whether a first diagnostic agent is functional, in response to a determination that the network connection is functional; causing the first diagnostic agent, residing on the media delivery device, to collect diagnostic data associated with the media delivery device, in response to a determination that the first diagnostic agent is functional; analyzing the diagnostic data to determine an operational problem associated with the media delivery device; removing the first diagnostic agent from the media delivery device; receiving a command in the first diagnostic agent to perform at least one of rebooting the media delivery device, upgrading an operating system in the media delivery device, and performing a remedial action related to the network

connection, in response to a determination that the network connection is not functional; uploading a second diagnostic agent to the media delivery device, in response to a determination that the first diagnostic agent is not functional; and removing the second diagnostic agent from the media delivery device.

It is respectfully submitted that the combination of Middeke and Herrbach fails to teach, disclose, or suggest each of the features specified in amended claim 1. For example, the aforementioned combination fails to disclose removing a first diagnostic agent, uploading a second diagnostic agent to a media delivery device in response to a determination that the first diagnostic agent is not functional, and removing the second diagnostic agent. Amended claim 18 includes a similar recitation.

In contrast and as stated in the Office Action, Middeke does not disclose fails to disclose removing a first diagnostic agent, uploading a second diagnostic agent to a media delivery device in response to a determination that the first diagnostic agent is not functional, and removing the second diagnostic agent. See Office Action, page 4, lines 4-7.

Herrbach fails to overcome Middeke's deficiencies. In contrast, Herrbach merely discusses establishing an initial state of a system to be tested. See col. 5, lines 26-27. In Herrbach, once the initial state is established tests are performed and a final state of the system is determined. See col. 5, lines 29-32. After the tests are performed a case cleanup is performed. See col. 5, lines 32-33. Herrbach's case cleanup can include returning the system to the initial state, checking for unexpected system behavior and release resources specific to the case. See col. 5, lines 36-41.

Consequently, Herrbach teaches determining an initial state, performing test, and returning to the initial state. In particular, Herrbach fails to teach or disclose removing a first

diagnostic agent, uploading a second diagnostic agent, and removing the second diagnostic agent. Rather Herrbach is silent regarding uploading and removing diagnostic agents.

Thus, based on the foregoing, amended claim 1 is allowable over the improper combination of Middeke and Herrbach and the rejection of this claim should be withdrawn. Claims 24, 5, and 34-36 depend from amended claim 1, and are thus allowable for at least the same reasons. Therefore, the rejection of these claims should also be withdrawn.

In addition, regarding claims 1, 2, 4-10, 12-22, 24-27, and 29-36, Applicants respectfully submit that the teaching of Middeke and Herrbach cannot be combined. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See MPEP 2143.01(V) (citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See MPEP 2143.01(VI) (citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Middeke discloses a system including a modem interface that can be used to receive commands, permitting service technicians to remotely re-configure a receiver. See Middeke, col. 2, lines 9-11. (Emphasis added) Middeke states:

> This arrangement permits more effective trouble-shooting by service technicians located at a service center. By analyzing diagnostic information received directly from the receiver and remotely re-configuring the same, service technicians may be able to forego the lengthy process of walking end customers through a series of questions and/or steps in an attempt to resolve receiver problems.

Id. at col. 2, lines 12-18. (Emphasis added.)

In contrast, Herrbach discloses "techniques for testing complex telecommunication systems employ testing software that is designed to emulate the tests that previously had been performed manually by testing personnel." See Herrbach, col. 1, lines 25-28. (Emphasis added.) Herrbach goes on to disparage service technician interaction by stating that:

> [S]o-called automated tests are performed under control of [a test] operator of a test computer. The [test] operator must remain in attendance to respond to problems encountered in performing any of the automated tests and to take steps to cause the telecommunication system to recover from any failures of the system caused by the tests being performed. For example, if the automated test requires a particular system resource . . . the test operator [service technician] must then look for and select an alternative resource to perform the test. Likewise, if the system fails, the test operator must return the system to a predetermined state in order for the testing to continue.

> Id. at col. 1, lines 28-38. (Emphasis added.) Therefore, Herrbach precludes service technicians from interacting with its systems by disclosing "fully automated test systems, or unattended, automated test systems that do not require a test operator in attendance." Id. at col. 54-56.

Applicants therefore respectfully submit that the proposed combination of Middeke and Herrbach is impermissible because it would render the Herrbach being unsatisfactory for its intended purpose. In other word, because Herrbach precludes service technician interaction, Herrbach cannot be combined with a system that has service technician interaction. As a result, there is no suggestion or motivation to make the proposed modification. Moreover, since the proposed combination of Middeke and Herrbach would change the principle of operation of Herrbach (i.e. inclusion of service technician interactions) "then the teachings of the [Middeke and Herrbach] are not sufficient to render the claims *prima facie* obvious." See MPEP 2143.01(VI). Consequently, Applicants respectfully submit that the teaching of Middeke and Herrbach cannot be combined.

Thus, based on the foregoing, claim 1, 2, 4-10, 12-22, 24-27, and 29-36 are allowable over the improper combination of Middeke and Herrbach and the rejection of this claim should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants' attorney at the number listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,

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